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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/407,136	09/27/1999	VADIM SHTEYNBERG	99RE036	2345

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EXAMINER

TUGBANG, ANTHONY D

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 07/01/2003

25

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/407,136

Applicant(s)

SHTEYNBERG ET AL.

Examiner

A. Dexter Tugbang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,21 and 23-36 is/are pending in the application.
- 4a) Of the above claim(s) 27 and 28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,21,23-26 and 29, 34-36 is/are rejected.
- 7) ☒ Claim(s) 30-33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The applicants' amendment filed 4/16/03 has been fully considered and made of record. The examiner wishes to thank the applicants' for correctly pointing out that Claims 24-33 were not addressed in the previous Office Action (Paper No. 23). Claims 24-33 are addressed as follows.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 27 and 28, drawn to holding segments in a rotary clamp, classified in class 29, subclass 760.
 - II. Claims 21, 23, 24 and 34-36, drawn to winding segments with a wire dispenser, classified in class 29, subclass 605.

The inventions are distinct, each from the other because of the following reasons:

4. Inventions of Groups I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of Group II has separate utility such as clamping the segments. See MPEP § 806.05(d).

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5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. Claims 2, 25, 26 and 29 link(s) inventions of Groups I and II. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s), Claim 2.

Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

7. Pending Claims 27 and 28 are directed to an invention that is independent or distinct from the invention originally claimed for reasons set forth above.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, Claims 27 and 28 have been withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Objections

8. Claims 30-33 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In this case, Claims 30-33 each depend from previously cancelled Claim 3. Claims 30-33 have not been further treated on their merits.

Claim Rejections - 35 USC § 102

9. Claims 2, 24, 25, 26, 29, 34 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Shramo et al 5,425,165.

Shramo discloses a method of constructing a segmented wound member comprising: winding N sets of at least 3 stator segments (An, Bn, Cn), each set corresponding to a phase of the electromechanical device and each segment defining a bobbin (shown in Fig. 10), the N sets of segments being wound with a single continuous length of wire for each set such that the segments of each set are electrically in series (see Fig. 7), including 1) arranging the segments in a side-by-side orientation along a central longitudinal axis (centerline of wiring form 62), 2) winding the segments about the central axis; and 3) repeating steps 1) and 2) for each of the remaining sets of the segments (see col. 10, lines 16-47); and combining the N sets of segments in a common circular arrangement (see Fig. 12), which meets all of the limitations of the claimed manufacturing method.

Regarding Claim 24, the claimed “wire dispenser” is read as the conventional winding machines (see col. 10, lines 30-35).

Regarding Claim 25, Shramo further teaches that more segments can be made, which would be inclusive of "four" (see col. 9, lines 64+).

Claim Rejections - 35 USC § 103

10. Claims 21 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shramo et al in view of JP'119.

Shramo discloses the claimed manufacturing method as previously discussed. Shramo does not mention a relative rotation in that the wire dispenser remains stationary and the segments rotate.

JP'119 shows a relative rotation in that a winding can occur with the segments 2 rotating and the wire dispenser 3 remaining stationary to form multiple segments of windings having the advantages of not decreasing the magnetic characteristics (see Purpose).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Shramo by including relative rotation of JP'119, to positively form multiple winding segments without decreasing the magnetic characteristics.

11. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shramo et al in view of JP'112.

Shramo, as relied upon above (in Claim 2), teaches substantially all of the limitations of the claimed manufacturing method except moving the wire dispenser in a direction parallel to the axis of rotation to a position adjacent to the next segment.

JP'112 teaches a winding process, by the use of an X-Y table 20 (shown in Fig. 4), in which the winding dispenser (nozzle 7) moves in an X-direction parallel to the arrangement of

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segments 3 in a side-by-side orientation, and in a Y-direction around the segments 3 to wind the segments (as shown in Figs 7 and 8). The X-axis (shown in Figures 10 and 11) is considered to be the centerline axis of rotation of the segments in the side-by-side orientation of which the segments are wound around as the winding dispenser (nozzle 7) moves parallel to this axis of rotation. JP'112 further teaches the step of moving the wire dispenser parallel to the axis of rotation of the centerline of segments (X-direction) to a position of the next segment 3, then returning to the winding step to wind the next segment 3, such that the winding step and the moving step are performed until all of the segments are wound (shown in the sequence of Figures 9-12). The benefits of such a winding process allow the multiple segments to be wound continuously (see Abstract and Constitution).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the method of Shramo et al, by moving the wire dispenser in a direction parallel to the axis of rotation to a position adjacent to the next segment, as taught by JP'112, to achieve the same function of winding multiple segments in a side by side orientation and advantageously wind the multiple segments continuously.

Response to Arguments

12. Applicant's arguments filed 4/16/03 (Paper No. 24) have been fully considered but they are not persuasive.

In regards to the merits of Shramo et al, the applicants' believe that Shramo does not teach that 1) during winding, each segment comprising a bobbin, and 2) combining the N sets of

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segments in a common circumferential adjacent circular arrangement to form the wound member.

The examiner most respectfully disagrees. First, the winding core 62 is equivalent to the claimed "bobbin". Whether the bobbin is flattened and removed is not precluded by the claims and it appears that the applicants' are arguing more specifically than that which is claimed. Second, Shramo shows (in Fig. 12) that the segments are combined into a common circumferential circular adjacent arrangement through the use of, or wrapping around, the cylindrical core 66 (further discussed by Shramo at col. 9, lines 65+).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the references of JP'119 and JP'112 are relied upon for the teachings of relative motions of a wire dispenser. All of the prior art above are common to the teachings of winding.

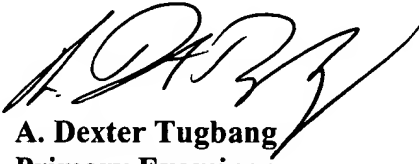
Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to A. Dexter Tugbang whose telephone number is 703-308-7599. The examiner can normally be reached on Monday - Friday 7:00 am - 3:30 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.



A. Dexter Tugbang
Primary Examiner
Art Unit 3729

June 30, 2003